



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,224	02/17/2000	Masashi Shiraishi	980110D/TL	6828

7590

04/09/2002

Frishauf Holtz Goodman Langer & Chick P C  
767 Third Ave  
25th Floor  
New York, NY 10017

EXAMINER

TUGBANG, ANTHONY D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/506,224

Applicant(s)

SHIRAISHI ET AL.

Examiner

Dexter Tugbang

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/033,789.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a process of fabricating a magnetic head device, classified in class 29, subclass 603.01.
  - II. Claims 6-12, drawn to a process of fabricating a magnetic head device, classified in class 29, subclass 603.04.
  - III. Claims 13-18, drawn to a process of fabricating a magnetic head device, classified in class 29, subclass 832.
  - IV. Claims 19-23, drawn to a process of fabricating a magnetic head device, classified in class 29, subclass 603.09.
  - V. Claims 24-29 drawn to a process of fabricating a magnetic head device, classified in class 29, subclass 834.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Groups II, III, IV and V, are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group I) as claimed does not require the particulars of the subcombination (Groups II, III, IV, V) as claimed because Group I does not require the specifics of: 1) selecting a head IC chip position defined by La as required by Group II; 2) rotating the magnetic disc when the head IC chip is in operation as required by Group III;

Art Unit: 3729

3) controlling a position of the suspension structure so that the head chip is located is located inside an outer periphery of the magnetic disc as required by Group IV; and 4) arranging for the head IC chip to be located with respect to the magnetic disc with a distance of 1000  $\mu\text{m}$  as required by Group V. The subcombination has separate utility such as an mounting an IC head chip on the suspension structure by an intervening portion.

3. Inventions of Group II and Groups I, III, IV and V, are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group II) as claimed does not require the particulars of the subcombination (Groups I, III, IV, V) as claimed because Group II does not require the specifics of: 1) mounting an IC head chip on the suspension structure by an intervening portion as required by Group I; 2) rotating the magnetic disc when the head IC chip is in operation as required by Group III; 3) controlling a position of the suspension structure so that the head chip is located is located inside an outer periphery of the magnetic disc as required by Group IV; and 4) arranging for the head IC chip to be located with respect to the magnetic disc with a distance of 1000  $\mu\text{m}$  as required by Group V. The subcombination has separate utility such as selecting a head IC chip position defined by La.

4. Inventions of Group III and Groups I, II, IV and V, are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations

(MPEP § 806.05(c)). In the instant case, the combination (Group III) as claimed does not require the particulars of the subcombination (Groups I, II, IV, V) as claimed because Group III does not require the specifics of: 1) mounting an IC head chip on the suspension structure by an intervening portion as required by Group I; 2) selecting a head IC chip position defined by La as required by Group II; 3) controlling a position of the suspension structure so that the head chip is located inside an outer periphery of the magnetic disc as required by Group IV; and 4) arranging for the head IC chip to be located with respect to the magnetic disc with a distance of 1000  $\mu\text{m}$  as required by Group V. The subcombination has separate utility such as rotating the magnetic disc when the head IC chip is in operation as required.

5. Inventions of Group IV and Groups I, II, III and V, are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group IV) as claimed does not require the particulars of the subcombination (Groups I, II, III, V) as claimed because Group IV does not require the specifics of: 1) mounting an IC head chip on the suspension structure by an intervening portion as required by Group I; 2) selecting a head IC chip position defined by La as required by Group II; 3) rotating the magnetic disc when the head IC chip is in operation as required by Group III; and 4) arranging for the head IC chip to be located with respect to the magnetic disc with a distance of 1000  $\mu\text{m}$  as required by Group V. The subcombination has separate utility such as controlling a position of the suspension structure so that the head chip is located inside an outer periphery of the magnetic disc.

Art Unit: 3729

6. Inventions of Group V and Groups I, II, III and IV, are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group V) as claimed does not require the particulars of the subcombination (Groups I, II, III, IV) as claimed because Group V does not require the specifics of: 1) mounting an IC head chip on the suspension structure by an intervening portion as required by Group I; 2) selecting a head IC chip position defined by La as required by Group II; 3) rotating the magnetic disc when the head IC chip is in operation as required by Group III; and 4) controlling a position of the suspension structure so that the head chip is located inside an outer periphery of the magnetic disc as required by Group IV. The subcombination has separate utility such as arranging for the head IC chip to be located with respect to the magnetic disc with a distance of 1000  $\mu\text{m}$ .

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

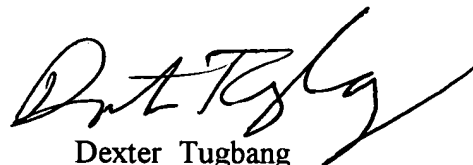
Art Unit: 3729

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, appearing to read 'Dexter Tugbang', with a stylized flourish at the end.

Dexter Tugbang  
Examiner  
Art Unit 3729

adt  
April 8, 2002